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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,491	09/05/2000	Ernst Messerschmid	1319.GLE.PT	7428
26986	7590	06/28/2006	EXAMINER	
MORRISS O'BRYANT COMPAGNI, P.C. 136 SOUTH MAIN STREET SUITE 700 SALT LAKE CITY, UT 84101			ZIMMERMAN, BRIAN A	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/622,491

Applicant(s)

MESSERSCHMID ET AL.

Examiner

Brian A. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 57-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**EXAMINER'S RESPONSE****Status of Application**

In response to the applicant's amendment received on 5/12/06. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 57-89 are unpatentable for the reasons set forth in this office action:

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 57,58,60-62,64-71,74-76,78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badger (5729192), Lee (6091340) and Sues (5229648) and the admitted prior art.

Badger shows vehicle-disabling system where a disabler 10 receives a radio signal from flying bodies 38. The receiving disabler, once determining a proper signal has been received, then permanently disables one of a plurality of components. See col. 2 lines 13-15 and col. 6 lines 15-19. Since this is a permanent deactivation, the part must be replaced in order for the part or component to work again. Badger shows the satellite 38 is in the air, and can therefore be considered an air-borne source. The receivers of Badger include decoder logic and are integrated in the vehicle.

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In an analogous art, Lee shows a vehicle disabling system where a plurality of essential components (20,28,44,45,48) in the vehicle each include a receiver to receive a disable signal from a remote source. The remote source being a controller 16 or a telephone, see col. 4 line 39. Having each component include a receiver to receive the disable signals increases the security and provides a certain amount of redundancy in the system since the user can disable the vehicle by successfully disabling at least one of the components and prevents components from being used in other vehicles. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have receivers in each of the components of Badger to receive the disable signal from the broad coverage satellite since Lee suggests that having each component able to receive signals prevents not only the vehicle from starting but also prevents the components from being used in other vehicles.

In an analogous art, Sues teaches a plurality of protected devices each having the ability to shut off the automobile if any one of the devices is not authentic. The vehicle will not run if any one of the components is incorrect. Therefore each component is essential to operating the vehicle. The concept taught by Sues is that each element 'has the power' to disable the vehicle if that element is determined to be not authentic. By giving this 'power to disable' to each element, the operation of the security system to disable the vehicle is greatly increased since the potential thief cannot merely disable a single authentication device in one component.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the authentication elements of Badger-Lee (namely the receiver and comparison elements) in each component necessary to the operation of the vehicle since, as suggested by Sues, such would greatly increase the ability to disable the vehicle and prevent theft.

Regarding the limitation of having a check sum in the communication for error detection, the examiner had taken official notice that the use of a check sum in a communication for error detection is very well known and common in the art at the time of the invention, the applicant did not traverse the taking of Official Notice, therefore it is considered that the limitation discussed here is shown by the admitted prior art as per MPEP 2144.03C which states:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate.

Regarding the term worldwide ID, the use of unique identification in Badger is equivalent to the claimed worldwide ID.

The examiner had taken official notice that paging signals (like those of Badger) commonly occur once in a time period and can alternately be transmitted periodically in order to ensure reception. As per MPEP 2144.03 C, this is now considered admitted prior art.

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2. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Badger, Lee and Sues and the admitted prior art as applied to claim 57 above, and further in view of Besharat (6219540).

In an analogous art, Besharat shows an indication to the user that the user should bring the communication device within range to improve normal operation of the communication device. See figure 3. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have indicated an out of range error to the user to avoid improper operation of the above modified disablement system.

3. Claims 63 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badger, Lee and Sues and the admitted prior art as applied to claim 57 above, and further in view of Hertel (5532690).

In an analogous art, Hertel shows a vehicle disabling system that disables the vehicle after a time delay in order to safely provide disabling of the vehicle. See col. 5 lines 15+.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a time delay in disabling the vehicle in the above discussed system in order to ensure safe disabling of the vehicle.

4. Claims 72,73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badger, Lee and Sues and the admitted prior art as applied to claim 57 above, and further in view of Suzarka (6285860).

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In an analogous art, Suzarka shows a vehicle shutdown or disable system that uses an interrogation-response communication to determine the location and authentication of the vehicle in order to properly disable the desired vehicle. See abstract. Therefore, it would have been obvious to have used interrogation-response communication in order to provide improved security in the disable system discussed above.

5. Claims 79-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badger, Lee and Sues (5229648) and the admitted prior art.

Badger shows vehicle-disabling system where a disabler 10 receives a radio signal from flying bodies 38. The receiving disabler, once determining a proper signal has been received, then permanently disables one of a plurality of components. See col. 2 lines 13-15 and col. 6 lines 15-19. Since this is a permanent deactivation, the part must be replaced in order for the part or component to work again. Badger shows the satellite 38 is in the air, and can therefore be considered an air-borne source. The receivers of Badger include decoder logic and are integrated in the vehicle.

In an analogous art, Lee shows a vehicle disabling system where a plurality of essential components (20,28,44,45,48) in the vehicle each include a receiver to receive a disable signal from a remote source. The remote source being a controller 16 or a telephone, see col. 4 line 39. Having each component include a receiver to receive the disable signals increases the security and provides a certain amount of redundancy in the system since the user can

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disable the vehicle by successfully disabling at least one of the components and prevents components from being used in other vehicles. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have receivers in each of the components of Badger to receive the disable signal from the broad coverage satellite since Lee suggests that having each component able to receive signals prevents not only the vehicle from starting but also prevents the components from being used in other vehicles.

In an analogous art, Sues teaches a plurality of protected devices each having the ability to shut off the automobile if any one of the devices is not authentic. The vehicle will not run if any one of the components is incorrect. Therefore each component is essential to operating the vehicle. The concept taught by Sues is that each element 'has the power' to disable the vehicle if that element is determined to be not authentic. By giving this 'power to disable' to each element, the operation of the security system to disable the vehicle is greatly increased since the potential thief cannot merely disable a single authentication device in one component.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the authentication elements of Badger-Lee (namely the receiver and comparison elements) in each component necessary to the operation of the vehicle since, as suggested by Sues, such would greatly increase the ability to disable the vehicle and prevent theft.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the disabling component disable multiple other



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components in the vehicle to eliminate the need for disabling elements in every component.

Regarding the limitation of having a check sum in the communication for error detection, the examiner had taken official notice that the use of a check sum in a communication for error detection is very well known and common in the art at the time of the invention. As per MPEP 2144.03 C, this is now considered admitted prior art.

Regarding the term worldwide ID, the use of unique identification in Badger is equivalent to the claimed worldwide ID.

The examiner had taken official notice that paging signals (like those of Bishop) commonly occur once in a time period and can alternately be transmitted periodically in order to ensure reception. As per MPEP 2144.03 C, this is now considered admitted prior art.

6. Claims 85,87,88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badger, Lee and Sues and the admitted prior art as applied to claims 79,80 above, and further in view of Kaish (4494114).

In an analogous art, Kaish shows a disabling device that renders electronic appliances inoperable to prevent or dissuade theft. The examiner had taken official notice that the claimed elements set forth in these claims are common well-known electronic appliances. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the above modified disabling system to render electronic keys and smart cards

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inoperable in order to deter theft. As per MPEP 2144.03 C, this is now considered admitted prior art.

7. Claims 86 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badger, Lee and Sues and the admitted prior art as applied to claims 79 above, and further in view of Rohrbach (5898783).

In an analogous art, Rohrbach shows a disabling device that renders portable telephone appliances inoperable to prevent or dissuade theft. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the above modified disabling system to render portable telephone appliances inoperable in order to deter theft.

### ***Response to Arguments***

Applicant's arguments filed 5/12/06 have been fully considered but they are not persuasive.

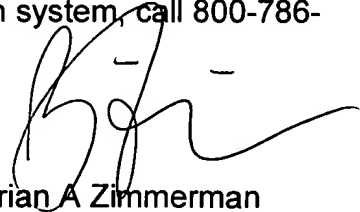
The applicants argue against the Bishop-Badger-Sues rejection by articulating that the references do not show each electronic component receiving a signal from an air-borne source. While the examiner still does not agree that the claims are so narrow, a new grounds of rejection is made above directed to the claims as argued. It remains the examiner's position that the claims require a receiver in each component that can receive a signal that was "at one time" transmitted from an air-borne source.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on 7 am to 4 pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brian A Zimmerman  
Primary Examiner  
Art Unit 2612

BZ